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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,054	01/26/2001	Richard A. Mallo	56147USA8A.002	7236

EXAMINER	
FUBARA, BLESSING M	

ART UNIT	PAPER NUMBER
1618	

MAIL DATE	DELIVERY MODE
11/15/2007	PAPER

7590 11/15/2007
Attention: Yen Tong Florczak
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/771,054	MALLO ET AL.	
	Examiner	Art Unit	
	Blessing M. Fubara	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-34, 36, 37 and 39-51 is/are pending in the application.
- 4a) Of the above claim(s) 37 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-38, 38-41 and 43-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of request for continued examination under 37 CFR 1.114 and remarks filed 08/09/07 and amendment filed 7/31/07. New claims 44-51 are added. Claims 35, 38 are canceled. Claims 29-34, 36, 37 and 39-51 are pending.

Response to Arguments

Previous rejections that are not reiterated herein are withdrawn.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/09/07 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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4. Claims 30-34 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 30 recites the limitation "the reaction product" in line . There is insufficient antecedent basis for this limitation in the claim.

6. Claims 30-36, 38, 43, and 45-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is written description.

A lack of adequate written description issue arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996). In the present case, the claimed invention in claim 30 recites "at least one hydrophilic component." The specification at paragraphs [0043] and [0044] of the published application guides one to appreciate what applicant intends the hydrophilic component to be in at least structural sense but the guidance derived from the instant specification points to hydrophilic component that is defined solely by function terms without describing in concrete terms and structures what the components are. For example, water is hydrophilic so also is a host of other hydrophilic components such that the artisan would have to screen every component that is hydrophilic to arrive if at all at what applicant regards as hydrophilic

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component. Defining hydrophilic component strictly only by functional terms appears to lead the artisan on a hunting expedition.

An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. This is lacking in the instant case

The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus. See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406. This is also lacking in the instant case.

A "representative number of species" means that the species, which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the genus. The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure "indicates that the patentee has invented species sufficient to constitute the gen[us]."

Applicant has not provided a description of the structure or chemical name of a representative number of compounds. In other words, the Applicant has not described with sufficient clarity a hydrophilic component that is the claimed invention.

No arguments are presented with the filing of the RCE.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 29-38, 38-41 and 43-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over de la Poterie et al. (US 5,972,354) or Kantner et al. (US 6,433,073) or Scholz et al. (US 6,605,666).

de la Poterie discloses cosmetic composition in the form of lipstick or foundation as recited in instant claim 41 (column 1, lines 9-14, 40-54) for application to the skin (column 1, line 9); the application of the composition meets the instant method of applying the composition

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to the skin. de la Poterie discloses the formation of a film over the skin or the lip upon applicant of the composition (column 1, lines 40-49), which meets film formation over the skin as in instant claim 1. The composition that is applied to the skin to form the film comprises polyester polyurethane, siloxane or organic compound having a sulfonic group, ethylene diamine that meets the chain extender limitation of the claims, glycols that meet the limitation of hydrophilic compound (column 3, lines 13-64) and dyes and pigments (column 5, line 62 to column 6 line 26). de la Poterie does not teach the silicone or silyl compounds of claims 29 and 50.

However, the claims would have been obvious a person of ordinary skill in the art would have been motivated to use any of the silyl or siloxane compounds.

Kantner discloses polyurethane dispersion containing isocyanate terminated polyurethane having the structure in instant claims 38 and 43 (abstract; column 4, lines 13-19; column 9, lines 38-67); ethylene diamine (column 4, line 17) meeting the chain extender of claims 30 and 34; mixture of alcohol and water (column 4, line 10) meeting the hydrophilic compound of claim 30; diisocyanate and polyester diol (column 4, lines 15-17) meeting the isocyanate and diol limitations of claims 30-32; the polyols of Kantner have molecular weight of 62 to 10,000, preferably 200 to 5,000, and most preferably from 400 to 3,000 (column 6, lines 41-43) meeting claim 33; the composition is applied to the skin as foundation, moisturizer and is also applied to the nails (column 5, lines 21, 29-37) and when applied, the application process meets the generic method claims 29 and 30, the composition dries to a film of about 0.025 millimeter in thickness (claim 18) meeting instant claim 39. Kantner does not teach the specific silyl compounds of claims 29 and 50. But the claims would have been obvious a person of ordinary skill in the art would have been motivated to use any of the silyl or siloxane compounds.

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Scholz discloses composition that is applied to the skin, which dries to 0.025 millimeter film in thickness (column 3, lines 41-50 and 61; claim 19) meeting claims 29 and 39. The composition of Scholz is a dispersion comprising silyl terminated polyurethane (column 9, lines 34-66), polyisocyanates, tertramethylene diisocyanate (column 7, line 55 to column 8 line 4), alcohol-water mixture (column 8, line 17) and carbowax (column 10, lines 21-30) that meets hydrophilic compound; polyalkylene diols or tetrols or triols (column 10, lines 4 and 43) or polyester diols, triols, or tetrols (column 10, line 44) that meet claims 29, 31 and 32; alkylene diamines (column 10, lines 43 and 44) that meet the chain extender of claim 34; surfactant (column 10, lines 25-34) as in instant claim 40. Scholz does not teach the specific silyl compounds recited in claims 29 and 50. But the claims would have been obvious a person of ordinary skill in the art would have been motivated to use any of the silyl or siloxane compounds.

No arguments were presented with the filing of the RCE.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Blessing Fubara
Patent Examiner
Tech. Center

A handwritten signature in black ink, appearing to read "Blessing Fubara", is written over the printed name.